

Neifeld Docket No: CAT29US-SCRCO3

Application/Patent No: 09/756,788

USPTO CONFIRMATION NO: 6599

File/Issue Date: January 10, 2001

Inventor/Title: MICHAEL C. SCROGGIE ET AL./System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: JANVIER/3688

ENTITY STATUS: LARGE

37 CFR 1.181 PETITION TO FOR CONSIDERATION BY THE USPTO DIRECTOR/OFFICE
OF PETITIONS TO REINSTATE APPEAL BRIEF

I. STATEMENT OF RELIEF REQUESTED

The applicant seeks review of the decision by the examiner in the notice of non-compliant appeal brief dated January 26, 2009. The applicant requests reinstatement of the appeal brief filed October 23, 2008.

II. STATEMENT OF MATERIAL FACTS IN SUPPORT OF THE PETITION

1. On October 10, 2001, the applicant filed this application and a preliminary amendment presenting claims 32-58.
2. On January 21, 2003, the Office mailed a non-final office action, which examined and rejected claims 32-58.
3. On April 17, 2003, the applicant filed an amendment and added claims 59-91.
4. On September 17, 2003, the Office mailed a final office action, which examined and rejected claims 32-58.
5. On March 15, 2004, the applicant filed an appeal brief containing claims 59-91.
6. On May 4, 2004, the Office mailed a final office action, which examined and rejected claims 32-91.
7. On August 4, 2004, the applicant filed an appeal brief containing claims 59-91.
8. On October 29, 2004, the Office reopened prosecution and mailed a non-final office action and required an election/restriction regarding claims 32-91.
9. On January 28, 2005, the applicant filed a response to the election of species requirement; and filed a supplemental appeal brief for reinstatement of the appeal.
10. On February 3, 2005, the applicant filed a petition from the requirement of restriction.
11. On April 18, 2005, the Office mailed a non-final office action and required an election/restriction regarding claims 32-91.
12. On June 24, 2005, the applicant filed an appeal brief containing claims 59-91.
13. On July 1, 2005, the applicant filed a petition from the requirement of restriction.
14. On September 21, 2006, the Office mailed a notice of non-compliant appeal brief in response to the appeal brief filed June 24, 2005.
15. On October 17, 2006, the applicant filed an appeal brief containing claims 59-91.
16. On September 17, 2008, the Office reopened prosecution and mailed a non-final office action, which examined claims 32-91.
17. On September 29, 2008, the applicant filed a response to the office action which included

claim amendments and new claims 92-97.

18. On October 23, 2009, the applicant filed an appeal brief.

19. On January 26, 2009, the office issued a notification of non-compliant appeal brief. This paper improperly states in checked box 10 that:

This Application is not in condition for appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature. On 9/17/08, the Office mailed a Non-Final Action to the Applicant. On 9/29/08, the Applicant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before the Examiner issues a response to the 1.111 reply, Applicant filed on 10/23/08 a Notice of Appeal together with an Appeal Brief. Here, the Applicant can either render the 1.111 reply null and void to thereby proceed with the Appeal after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered by the Examiner.

20. On January 26, 2009, the applicant filed a request for reconsideration in response to the January 26, 2009 notification of non-compliant appeal brief.

21. On January 30, 2009, the applicant filed a petition to the Director to: (1) invoke supervisory authority; and (2) withdraw the January 26, 2009 notification of non-compliant appeal brief.

22. On April 10, 2009, the Office mailed a decision on the January 30, 2009 petition: (1) denying the request to invoke supervisory authority and (2) granted the request to withdraw the January 26, 2009 notification of non-compliant appeal brief.

23. The April 10, 2009 decision states that: "Accordingly, the application is being forwarded to the examiner for consideration of the September 29, 2008 amendment."

24. On May 13, 2009, the applicant filed a petition to review the decision by a technology center director. This petition has not yet been decided.

25. On May 29, 2009, the Office issued an examiner's answer, which considered the version of claims 32-91, which were filed April 17, 2003, in direct contradiction to the direction in the April 10, 2009 decision to consider the September 29, 2008 amendment.

26. On June 2, 2009, the applicant filed a reply brief.

27. On June 2, 2009, the applicant filed a petition to request that the examiner examine claims 32-97, submitted in the September 29, 2008 amendment.

28. 35 USC 132(a) states that:

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention. [Underlining added for emphasis.]

29. 35 USC 134(a) states that:

35 U.S.C. 134 Appeal to the Board of Patent Appeals and Interferences.

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal. [Underlining added for emphasis.]

30. Ex parte Lemoine states in relevant part that:

To reach a decision requires to construe the word "claims" as used in § 134. The word is susceptible to at least two interpretations. It can refer to the claims of an application, i.e., the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S.C. § 112, ¶2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent. Section 134 merely uses the word "claims." We must, therefore, decide which construction to give to the statute. We conclude that "claims" in § 134 should be construed consistently with its use in § 132 to mean "claims for a patent" rather than particular "claims of an application."

Section 134 is part of Chapter 12 of Title 35. Chapter12 is titled "Examination of Application" and sets forth the general procedures to be followed in the Office for examination. Sections 131 to 134 provide the general procedures relating to ex parte examination. In relevant part, these sections specify that (1) an examination shall be made (§ 131); (2) if "any claim for a patent" is rejected, the applicant shall be informed of the bases of the rejection (§ 132); (3) if the applicant persists in the "claim for a patent, with or without amendment," the application shall be reexamined (§ 132); and (4) if applicant's claims have been twice rejected, the applicant may appeal (§ 134). Considering these sections together, we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." *Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected.* Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction. [Ex parte Lemouine, 46 USPQ2d 1420, ___ (PTOBAI 1994)(precedential decision of a BPAI expanded panel, 12/27/1994). Underlining and italics added for emphasis.]

31. 37 CFR 41.37(a) specifies the rule depending from 34 USC 134(a), stating that:
 - § 41.31 Appeal to Board.
 - (a) Who may appeal and how to file an appeal. (1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply. [Underlining added for emphasis.]
32. 37 CFR 41.31 was promulgated in the Final Rule published 8/14/2004, at 69 FR 49960.
33. Comment 36 in the Final Rule published 8/14/2004 states that:

Comment 36: One comment suggests that §§ 41.31(a)(1), (a)(2) and (a)(3) be amended to provide for appeal at any time after being twice or finally rejected,

as appropriate, during pendency of the proceeding where no time period under § 1.134 is running. The comment states that the suggested change would ensure that § 41.31 would not be interpreted more restrictively than 35 U.S.C. 134, which sets forth no condition regarding when an appeal can be filed, apart from the requirements for claims being twice rejected (as in 35 U.S.C. 134(a)) or finally rejected (as in 35 U.S.C. 134(b) and (c)). *The comment also states that this amendment would prevent any potential inconsistency of the rules with the Board's precedential opinion, Ex parte Lemoine, 46 USPQ2d 1420, 1423 (BPAI 1994).*

Answer: The suggestion will not be adopted. Sections 41.31(a)(1), (a)(2) and (a)(3) were proposed to generally incorporate the requirements of former § 1.191(a) (2003) and to subdivide § 1.191(a) into three parts to improve readability. Both former § 1.191(a) (2003) and §§ 41.31(a)(1), (a)(2) and (a)(3) are more restrictive than 35 U.S.C. 134 in that an appeal must be filed within the time period provided under § 1.134 for response to either a final rejection or a non-final rejection which rejects the claims for a second time, as appropriate. For example, an applicant for a patent whose claims have been twice rejected but not finally rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134. However, if such an applicant files an amendment within the time period provided under § 1.134, the applicant may not file an appeal *outside the time period provided under § 1.134*. In such a situation, the applicant must wait for a new rejection by the examiner before an appeal can be filed. [69 FR 49974 right hand column; bold and italics added for emphasis.]

34. Substantially the same issue (appeal, office action, amendment, renewed appeal, and then objection to the renewed appeal and then withdrawal of appeal via an improper Notice of Non Compliant Appeal Brief) is present in US 10/497,852, filed June 7, 2004, attorney docket number PIP-93-KLAP-US, and the applicant has requested via petition that the PTO Director review that Group director's decision on petition in that case.

III. REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED

In this and many other cases in the business methods area, the applicant has been seeking BPAI appellate review in order to achieve finality and repose, only to be stymied by the examiner corps' tactics of reopening prosecution in response to appeal only to belatedly issue restrictions, impose new belated rejections, and objecting to appeal briefs based upon requirements not in the rules of practice for appeals. These delay tactics are tantamount to a denial of due process, since their effect is to indefinitely tie up the application in the examining corps, preventing the BPAI from obtaining jurisdiction and determining whether the merits of the rejections are proper. That situation is partially apparent here from Facts 1-27. This petition is filed in this specific case, but the issue it raises is generic in this respect. For example, substantially the same issue (appeal, office action, amendment, renewed appeal, and then objection to the renewed appeal) is present in US 10/497,852, filed June 7, 2004, attorney docket number PIP-93-KLAP-US. There, the applicant also petitioned, and the petition has not been decided.

The appeal brief filed October 23, 2008 was after the applicant's claim for a patent had been twice or more rejected. Facts 1-18. As clearly explained in Ex Parte Lemoine, 35 USC 134(a) specifies that an applicant has the right to appeal any time their claim for a patent has been twice or more rejected, regardless of amendments to the invention claims, which is the case here. Facts 28-30. As in Lemoine, the existence of amended claims is not relevant to the right to appeal. Accord: Appeal Nos: 20074469; 20061027, available from the BPAI web site of final decisions.

Lemoine construes the statutory rights in 35 USC 132 and 134, to provide an absolute right of appeal any time an applicant's request for a patent has been twice or more rejected. The statutory right trumps any regulatory provision, or construction of a regulatory provision, to the contrary. The regulatory provision 37 CFR 41.31 is not to the contrary. Facts 28-30. Moreover, as noted in fact 33 above which is a copy of comment 36 in the Final Rule published 8/14/2004 on 37 CFR 41.31(a) clearly indicates that 37 CFR 41.31(a) was not intended to violate 35 USC 132/134 as construed in Lemoine. Comment 36 states in most relevant part that "However, if such an applicant files an amendment within the time period provided under § 1.134, the applicant **may not** file an appeal **outside the time period provided under § 1.134.**" The only possible construction of the clause, "the applicant **may not** file an appeal **outside** the time period provided under § 1.134." when the applicant has timely filed an amendment, is that the applicant **may file** an appeal **inside** the time period provided under 1.134. Otherwise, the recitation "**outside** the time period provided under § 1.134." is meaningless. In other words, the Director

addressed this specific issue of when the applicant can appeal after amending, when promulgating 37 CFR 41.31(a). The specific issue is addressed in comment 36 to the final rule discussed above. The Director there construed the right of appeal to be consistent with Lemoine, providing a right of appeal by specifying that the applicant had the right to file the Notice of Appeal specified by 37 CFR 41.31(a) within the time limit set in the prior office action, regardless of whether the applicant had also filed an amendment in response to the office action.

Thus, properly construed, 37 CFR 41.31(a) is consistent with the statute and Lemoine, and provides no bar to filing an appeal after an amendment to the claims, so long as the appeal is filed timely, - - within the time provided in the prior office action. Therefore, the applicant had the right under rule 41.31, 35 USC 134(a), and Ex parte Lemoine, to file the appeal.

Moreover, the examiner's assertion under checked box 10 in the Notice: "This Application is not in condition for appeal. Indeed, the filing of an Appeal Brief in the Instant Application is premature" is incorrect. An application is not premature for appeal whenever the applicant's request for a patent has been twice or more rejected.

Furthermore, the examiner has alternatives in the appeal process to address amendments. Under the rules now in force the examiner can reply in an answer, with a new ground of rejection of any claim, if the examiner so desires. 37 CFR 41.39(a)(1), added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004 (noting that rules intended to go into for 12/2008 were indefinitely suspended and are not in force.)

Still further, leaving the most recent improper Notice undisturbed detracts from the applicant's substantive rights by further delaying the date this application will issue as a patent.

Finally, patent term adjustment depends upon duration of appeal, and upon delays due to the filing of correcting papers. Therefore, the examiner's requirement may affect the applicant's substantive right to duration of patent term once this application issues.

For all of the foregoing reasons, the Notice should be withdrawn and the appeal filed October 23, 2008 should be considered.

IV. COORDINATING PETITION DECISION WITH DECISION IN US 10/497,852

The Director should coordinate decision on this petition with the petition for review by the Commissioner's Office in in US 10/497,852, filed June 7, 2004, attorney docket number PIP-93-KLAP-US.

Respectfully Submitted,

6/29/2009 /BruceMargulies#64,175/

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